

**REMARKS**

Claims 9-12, 14, 17 and 19-21 were previously pending in the application and remain unchanged.

Claims 9-11, 14, 17, 19 and 20 were rejected under 35 USC §103(a) as being unpatentable over German publication G 90 14 463.5 (hereinafter “DE ‘463”) in view of Japanese publication 2001-74359 (hereinafter “JP ‘359”).

Claims 9 and 19 both recite, among other things, the compartment divider having a chamber with an “open bottom” allowing items held within the compartment divider to rest on the bottom of the box shaped body.

Fig. 3 of DE ‘463 illustrates the formed part (22) defining an inner region with an open top and a closed shelf bottom beneath the inner region. The closed shelf bottom allows the formed part to retain small items within the enclosed inner region.

Fig. 4 of JP ‘359 illustrates a container for a refrigerator door having an open bottom and allowing the item to extend through the bottom of the container.

As acknowledged by the Examiner, DE ‘463 does not disclose the chamber of the divider as having an open bottom. The Examiner takes the position that “it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the divider of DE ‘463 so as to utilize an open bottom as unequivocally taught by JP ‘359 because this arrangement would enhance the retaining capacity of DE ‘463’s divider when long items are desired to be held within the chamber since the open bottom would afford additional storage capacity with enhanced holding capabilities of the long items [since the item is now seated within the divider as opposed to being seated upon the divider] in order to safely retain the items as clearly demonstrated by JP ‘359 [due to pivoting motion exhibited on the items when the refrigerator door is swung open and shut].”

Applicants respectfully disagree and request reconsideration. A proposed modification cannot render the prior art unsatisfactory for its intended purpose. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) The intended purpose of formed part (22) with the closed shelf bottom (30), as shown in Fig. 3 of DE ‘463, is to provide an enclosed bin that retains smaller items in a confined receptacle within the refrigerator door storage compartment. These smaller items can be placed within the bin

to prevent them from being scattered around the larger door storage compartment. If the formed part (22) of DE '463 was modified to eliminate the closed shelf bottom, as suggested by the Examiner and taught by JP '359, then the small items would fall out the open bottom and be scattered around the door storage compartment. The opening and closing movement of the door would cause the items to be moved within the larger door storage compartment and they could be crushed if a larger item, such as a gallon of milk, was then unknowingly placed on the item. Allowing the smaller items to fall out of the bin and be damaged would render the prior art unsatisfactory for its intended purpose of retaining these items in a confined receptacle. Therefore, there is no apparent reason to make the proposed modification.

The open bottom divider structure of JP '359 is intended for an entirely different purpose than the closed bottom container of Fig. 3 in DE '463. As described by the Examiner, the open bottom divider structure of JP '359 is useful to help prevent longer items from tipping over. However, DE '463 provides a different embodiment, as shown with tongue (31) in Fig. 4, to satisfy this purpose. DE '463 describes how the tongue (31) embodiment is useful for preventing bottles or long tubes from tipping over.

For these and other reasons, DE '463 and JP '359, either alone or in combination, do not teach or suggest the subject matter defined by independent Claims 9 and 19. Therefore, Claims 9 and 19 is allowable. Claims 10-12, 14 and 17 depend from Claim 9 and are allowable for the same reasons and also because they recite additional patentable subject matter. Claims 20 and 21 depend from Claim 19 and are allowable for the same reasons and also because they recite additional patentable subject matter.

Claim 12 further recites that the compartment divider of Claim 9 has at least one sidewall with a concave shape in a direction of said given depth.

Claim 21 further recites that the third and fourth sidewalls of the compartment divider of Claim 19 each have a concave shape bulging inwardly toward the chamber.

The Examiner takes the position that it would have been obvious to further combine JP '483 with the teachings of DE '463 and JP '359 to provide a compartment divider having a concave sidewall. Applicants respectfully disagree and request reconsideration.

First, JP '483 does not disclose a sidewall having a concave shape bulging inwardly toward a chamber. Rather, JP '483 shows a divider (8) with the end of the top panel having a curved shape. As clearly shown in Fig. 6 of JP '483, the curved portion is only on the edge of the top portion and does not extend downwardly. Therefore, this is not a curved sidewall as defined in the claims. Claim 19 recites that the third and fourth sidewalls extend between the first and second sidewalls on opposing sides of the compartment divider. Nothing in JP '483 provides any disclosure of a sidewall having a concave shape bulging inwardly. Furthermore, the top panel of the divider (8) is a solid panel. Even if this edge could be considered a sidewall, it does not bulge inwardly toward a chamber, since JP '483 does not disclose a chamber.

Second, it would not have been obvious to combine the references because JP '359 clearly *teaches away* from the proposed modification. As shown in Fig. 1 of JP '359, the container has multiple cylinder portions with *convex* shaped sidewalls that *bulge outwardly away* from the inner chamber. Also, the abstract of JP '359 specifically discusses how the outwardly bulging cylindrical shape is designed to house tube shaped articles.

Prior art must be considered in its entirety, including disclosures that teach away from the claimed invention. The Examiner cannot conveniently select some portions of the secondary reference to fill the gaps in the primary reference while disregarding other portions of the references that teach away from the proposed combination. Most, if not all, inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, mere identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps." In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

The Examiner has proposed modifying the teachings of DE '463 and JP '359 to result in a container having a shape being exactly the opposite of the shape specifically required in JP '359. Applicants believe such a modification would not have been obvious

to one of ordinary skill in the art following the teachings of JP '359. The container (1) of JP '359 having *convex* shaped sidewalls that *bulge outwardly away* from the inner chamber teaches away from the Examiner's proposed modification. Therefore, it would not have been obvious to make the proposed modification and there is no apparent reason to make the proposed modification.

For these and other reasons, DE '463, JP '359 and JP '483, either alone or in combination, do not teach or suggest the subject matter defined by Claims 12 and 21. Therefore, Claims 12 and 21 are allowable.

### CONCLUSION

In view of the above, entry of the present Amendment and allowance of Claims 9-12, 14, 17 and 19-21 are respectfully requested. If the Examiner has any questions regarding this amendment, the Examiner is requested to contact the undersigned. If an extension of time for this paper is required, petition for extension is herewith made.

Respectfully submitted,



Craig J. Loest

Registration No. 48,557

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BSH Home Appliances Corp.  
100 Bosch Blvd  
New Bern, NC 28562  
Phone: 252-672-7930  
Fax: 714-845-2807  
email: craig.loest@bshg.com